

REMARKS

Upon entry of the present amendment, claim 12 will have been amended by the incorporation therein of the substantive recitations of claim 19. Further, claim 16 will have been amended by the incorporation therein of the substantive limitations of claim 20. Finally, claim 17 will have been amended by the incorporation therein of the substantive limitations of claim 21. Accordingly, claims 19 to 21 will have been canceled without prejudice or disclaimer of the subject matter of these claims.

In view of the herein contained amendments and remarks, Applicants respectfully traverse each of the outstanding objections and rejections set forth in the above-mentioned Official Action. Further, Applicants respectfully request reconsideration and withdrawal of each of the outstanding objections and rejections together with an indication of the allowability of all of the claims pending in the present application. Such action is now believed to be appropriate and proper and is thus respectfully requested, in due course.

In the above-mentioned Official Action, the Examiner objected to the drawings filed in the present application on November 27, 2001. In particular, the Examiner asserted that the claims do not show every feature of the invention specified in the claims. Applicants respectfully traverse the Examiner's objection to the drawings and submit that the drawings fully comply with the requirements set forth under 37 C.F.R. § 1.83(a).

With respect to the first noted recitation of the pending claims, Applicants respectfully submit that the analyzer is clearly illustrated at least in Figure 2 of the present application. In particular, Figure 2 clearly illustrates the message analysis unit 202. In this regard, Applicants respectfully direct the Examiner's attention to paragraphs [0070] and [0072] (of the published application) which clearly describe the above noted function and operation of the message

analysis unit in analyzing the electronic mail address of the sender. It is respectfully submitted that since the drawing (e.g. Figure 2) clearly illustrate the message analysis unit, there is no need further illustrate the various functions and operational modes of the such already illustrated component.

With respect to the second quoted portion of Applicants pending claims it, is respectfully submitted that this feature is clearly illustrated in Figure 3. In this regard, Applicants respectfully note that Figure 3 illustrates the terminal administration table which contains telephone numbers 301 with which IP addresses are associated. Accordingly, by using this table the IP address of the receiving IP apparatus can be obtained based on the associated telephone number. Furthermore, in Figure 7, step ST709 indicates that the message is transmitted to the destination IP address in accordance with SMTP. The simple mail transfer protocol (SMTP) is a protocol commonly used for electronic mail communication which requires and utilizes an IP address of a recipient or destination. Thus, since step ST 709 indicates that the message is transmitted by SMTP, it is clear that the IP address is used in transmission and that the telephone number is not used in the message transmission.

Accordingly, Applicants respectfully submit that each of the above noted features of Applicants invention are clearly, fully and adequately illustrated in the drawings of the present application. Thus, an action indicating the withdrawal of the objection to the drawings is respectfully requested, in due course. In this regard, should the Examiner disagree with Applicants assertions regarding the adequacy of the drawings in the present application, the Examiner is respectfully requested to contact the undersigned so as to discuss and resolve this issue in an expeditious fashion.

In the outstanding Official Action, the Examiner rejected claims 22-27 under 35 U.S.C. § 112, first paragraph. The Examiner asserted that these claims fail to comply with the written description requirement. The Examiner asserted that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey that the inventors had possession of the claimed invention. In this regard, the Examiner indicated that the instant specification does not provide a description of the claimed invention with respect to the negative limitation in claims 25-27.

Applicants respectfully traverse the above noted rejection and submit that it is inappropriate. Initially, Applicants note that the "negative limitation" is only present in claims 25-27, but that the Examiner has additionally rejected claims 22-24 under 35 U.S.C. § 112, first paragraph. Nevertheless, Applicants respectfully traverse the rejection asserted under 35 U.S.C. § 112.

With respect to each of the above noted claims, Applicants respectfully submit that the above noted rejection is inappropriate. Further, Applicants respectfully submit that each of the recitations of these claims is fully, clearly, and adequately described in the specification of the present invention in a manner as to convey, to one skilled in relevant art, that the inventors had possession of the claimed invention.

With respect to the recitations of claims 22-24, the Examiner's attention is respectfully directed to paragraphs [0070] and [0072] the published application. In particular, Paragraph [0070] indicates and discloses that the message analysis unit analyzes the electronic mail address of the sender and divides it into the sender telephone number and domain. Further, paragraph [0072] discloses and indicates that in the header information of the electronic mail, the telephone number "9999 -- 99 -- 9999" is inserted to the portion indicating the destination (i.e., "RCPT

TO:"). Thus it is apparent that each of the recitations of claims 22 through 24 is clearly disclosed in Applicants originally filed specification.

With respect to the recitations of claims 25-27, the Examiner's attention is respectfully directed to, inter alia, Figure 7, step ST 709 which indicates that the message is transmitted to the destination IP address in accordance with SMTP. As previously noted, SMTP is an electronic mail transmission protocol that utilizes IP addresses but does not transmit electronic mail by the use of a telephone number. Thus the utilization of this well known mail transmission protocol, by definition, indicates and discloses to one of ordinary skill in the art, that the telephone number of the receiving IP address is not utilized in the transmission.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection of any of the claims in the present application under 35 U.S.C. § 112, first paragraph as based upon an inadequate disclosure.

In the outstanding Official Action, the Examiner rejected claims 12 and 15-17 under 35 U.S.C. § 102 (a) as being anticipated by HUNA (U.S. Patent No. 6, 438, 217). Claims 13 and 18 were rejected under 35 U.S.C. § 103(a) as unpatentable over a HUNA in view of RANALLI et al. (U.S. Patent No. 6,748,057). Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over HUNA in view of Goodman (U.S. Patent No 6, 735, 617). Claims as 19 to 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over HUNA further in view of NAQVI (EP 0967 779).

By the present response and without any manner acquiescing in the propriety of any of the Examiner's asserted rejections, Applicants have incorporated the recitations of claims 19, 20, 21, into independent claims 12, 16 and 17 respectively. It is respectfully submitted that the combined teachings of HUNA and NAQVI do not disclose, teach, suggest, or even render

obvious the combination of features recited in each of Applicants independent claims 12, 16, and 17 particularly as herein amended.

Applicant's invention is directed to a server apparatus, a communication system, and a method for controlling an e-mail transmission. Utilizing the server apparatus recited in claim 12 as a nonlimiting example of Applicants invention, the present invention is directed to a server apparatus connected to a transmitting IP apparatus, the transmitting IP apparatus transmitting an e-mail to a receiving IP apparatus via the server apparatus. The server apparatus includes a memory configured to store an IP address of the receiving IP apparatus in association with a telephone number of the receiving IP apparatus, the IP address of the receiving IP apparatus being distinct from an e-mail address. A receiver is configured to receive the e-mail from the transmitting IP apparatus, the e-mail including the telephone number of the receiving IP apparatus. An analyzer is configured to obtain, from the received e-mail, the telephone number of the receiving IP apparatus, and to obtain, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, the receiving IP apparatus of the IP address, being the same as the receiving IP apparatus of the telephone number. A converter is configured to determine, based upon the telephone number of the receiving IP apparatus, a terminal type and a domain of the receiving IP apparatus and to determine, based upon the terminal type, the IP address of the receiving IP apparatus. A transmitter is configured to transmit the received e-mail to the receiving IP apparatus of the telephone number, based on the stored IP address of the receiving IP apparatus.

It is respectfully submitted that none of the references relied upon by the Examiner in the outstanding Official Action, whether considered individually, or whether considered in any proper combination, contain disclosures that are adequate or sufficient to either anticipate or

even to render unpatentable at least the above noted combination of features. Accordingly, Applicants respectfully request reconsideration and withdrawal of each of the outstanding rejections together with an indication of the allowability of all of the claims pending in the present application, in due course. Such action is now believed to be appropriate and proper and is thus respectfully requested.

Since the recitations of claims 19 through 21 have been incorporated into each of the respective independent claims, Applicants will discuss the outstanding rejection as applied to claims 19 through 21. In other words, Applicants will discuss and point out the shortcomings and deficiencies of the rejections based upon HUNA and NAQVI

In setting forth the rejection, the Examiner indicated that HUNA, the primary reference, discloses, a transmitting IP apparatus (Figure 5, IP apparatus 504), servers (Figure 4, 404, and Figure 5, 512), as well as receivers, such 524 and 532 of Figure 5. In addressing claims 19 through 21, the Examiner admitted that HUNA does not disclose the recited limitations of the converter that is configured to determine, based upon the telephone number of the receiving IP apparatus, a terminal type and a domain of the receiving IP apparatus and to determine, based upon the terminal type, the IP address of the receiving IP apparatus. The Examiner relies upon NAQVI for this teaching. However, Applicants respectfully submit that the disclosure of NAQVI is inadequate and insufficient to teach the features upon which the Examiner relies thereupon and that are admittedly missing from the disclosure of the primary reference.

In this regard, Applicants respectfully note that HUNA relies on a server to obtain the IP address of a recipient. In this regard, the Examiner noted column 15, lines 13-21 as well as lines 46- 48. This is in stark contrast to the disclosure of NAQVI, of which a specific objective is to eliminate the use of a facsimile server. According to the teachings of NAQVI, a receiving

facsimile device converts a given destination address into a particular IP address to thus establish a direct IP connection between the sending and receiving locations for transmitting the facsimile messages. Thus, Applicants initially assert that there is no logical reasoning for modifying the contradictory disclosures of HUNA, which relies upon a server for obtaining an IP address of a recipient, with NAQVI whose objective and goal is to eliminate the use of a server.

Further, if the teachings of NAQVI are combined with those of HUNA, the result would be a device that that does not utilize a server and thus clearly does not disclose the features recited in Applicants claims. For these reasons alone it is respectfully submitted that Applicants claims are clearly patentable over the combination proposed by the Examiner.

Yet additionally, Applicants respectfully submit that even if the asserted references are combined as proposed, the combination of features defining applicants' invention would not be disclosed or rendered obvious thereby. In this regard, Applicants respectfully submit that NAQVI does not disclose determining a terminal type and a domain of the receiving IP apparatus. Moreover, and independently of the above, Applicants respectfully submit that NAQVI also does not disclose determining the IP address of the receiving IP apparatus based upon the terminal type.

In this regard, the Examiner's attention is respectfully directed to Figure 3 of the present application. The NAQVI reference, relied upon by the Examiner to overcome the deficiencies of the primary reference, merely teaches converting a destination address into an IP address as set forth in the portion of the disclosure thereof cited by the Examiner. However, there is no indication therein of determining a terminal type of a receiving IP apparatus and further of determining the IP address of the receiving IP apparatus based upon the terminal type.

For each of these additional reasons, it is respectfully submitted that the Examiner's rejection is inappropriate and should be reconsidered and withdrawn. Accordingly, an action to such effect is respectfully requested, in due course.

The various other rejections applied against the remaining dependent claims in the present application are also submitted to be inadequate and insufficient to render the features recited therein unpatentable. In this regard, Applicants note that the various dependent claims in the present application are patentable based upon their dependence from a shown to be allowable base claim as well as additionally based upon their own particular combinations of recited features.

Accordingly, Applicants respectfully request reconsideration and withdrawal of each of the outstanding objections and rejections set forth in the above mentioned Official Action, together with an indication of the allowability of all claims pending herein.

Applicants note that the status of the present application is after final rejection and that Applicants may not amend in application, as a matter of right, once a final rejection has issued therein. Nevertheless, Applicants submit that entry and consideration of the present amendment is appropriate and proper. Entry the present amendment is consistent with the guidelines under 37 C.F.R. § 1.116 and is thus respectfully requested.

In particular, the amendments to the claims merely incorporate therein previously pending and considered limitations from cancelled dependent claims. Accordingly, such amendments do not raise any new issues requiring further consideration or search but clearly place the present application in condition for allowance by pointing out the shortcomings of the references with respect to the claims. Regarding the objection to the drawings and rejection of the claims under 35 U.S.C. § 112, first paragraph Applicants, have traversed the same and have

pointed out the compliance of the present specification and drawings with appropriate regulations. Thus, Applicants traverse, also do not raise any new issues requiring further consideration or search.

Accordingly entry of the present amendment is submitted to be appropriate and proper and is thus respectfully requested, although the status of the present application is after final rejection.

SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have amended each of the independent claims by incorporating therein features from a previously pending dependent claim. Applicants have additionally traversed the Examiner's objection to the drawings and rejection under 35 U.S.C. § 112, first paragraph.

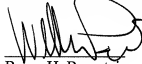
Applicants have discussed the features of the present invention and have contrasted the same with the disclosures of the references relied upon. Applicants have pointed out the shortcomings of the combination of references as well as the deficiencies of the disclosures of the references even if combined as proposed by the Examiner. With respect to the recitations of Applicants claims, Applicants have set forth and noted the substantial and significant shortcomings of the references with respect thereto. Accordingly, Applicants have provided clear evidentiary bases supporting the patentability of all the claims in the present application and respectfully request an indication to such effect, in due course.

Applicants have additionally pointed out a basis for entry of the present amendment, although the status of the present application is subject to final rejection.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.


Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,
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